

Claims 1-24 were rejected under 35 USC 103 as being unpatentable over Shukuzaki et al. (U.S. Patent No. 5,266,321) in view of Sunkel et al. (U.S. Patent No. 6,542,598). See Pages 2-4 of the Office Action. Applicants respectfully disagree.

As discussed in the prior amendment/responses, Shukuzaki et al. is silent with respect to mascara, which is applied to eyelashes and eyebrows. Rather, Shukuzaki et al. relates to cosmetics that are applied to the skin. See col. 1, line 68 through col. 2, line 3 of Shukuzaki et al., which states “the inventors have found that an oil make-up cosmetic which is less sticky and provides a fresh, smooth feeling to the skin but also superior make-up effects. (emphasis added).” Thus, the compositions of Shukuzaki et al. actually teaches away from mascaras, which require stickiness in order to help the compositions adhere to the hairs. Thus, one of ordinary skill in the art would not have been suggested to manufacture mascara by the teachings of Shukuzaki et al.

The Office Action recites that “Sunkel teaches cosmetic compositions comprising siloxane elastomers wherein the composition may be in the form of a foundation, mascara, eye shadows, powders, blushers, lip color, and the like . . . . Therefore, it would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to use the teachings of Sunkel within the teachings of Shukuzaki because Sunkel explicitly teaches cosmetic compositions comprising organosiloxane elastomers . . . .” See pages 3-4 of the Office Action.

As stated in the prior response, while Sunkel et al. does disclose the use of silicone elastomers in mascara (see Example II of Sunkel et al. at cols. 23-24), Sunkel et al. does not disclose, nor suggest, a mascara that “comprises less than about 1%, by weight, of wax,” as set forth in independent claim 1 of the present application. The mascara set forth in Example II of Sunkel et al. comprises 3%, by weight, of carnuba wax, 3.75%, by weight, of white beeswax, 2.25%, by weight, of paraffin wax 118/125, and 2.25%, by weight, of paraffin wax. Thus, Sunkel et al. does not teach, nor suggest, the mascara recited in independent claim 1 of the present application, which “comprises less than about 1%, by weight, of wax.”

The Office Action states that “Applicants argument that Sunkel does not teach less than about 1% by weight of wax is not persuasive, since, generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical.” See Page 6 of the Office Action. Applicants have attached hereto, as Exhibit A, a

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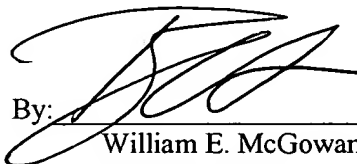
copy of PCT Patent Application No. WO00/74519 (the '519 Application"), assigned to Revlon Consumer Products Corporation, a major marketer of mascaras. As recited on page 1, line 13-22, "A 'gold standard' mascara should provide optimal length, color, thickness, and curl to the lashes. . . . One key ingredient in mascara formulas, namely wax, is believed to play a role in achieving all of the attributes mentioned above. That is why virtually all mascaras contain wax. However, waxes provide certain undesirable properties. In particular, waxes cause mascaras to increase in viscosity in storage . . . sometimes to a level which makes it difficult to use and apply. This causes problems for manufactures because such mascaras have reduced shelf life."

It is also interesting to note that despite the realization of the above-referenced drawbacks of the use of waxes, the two example of '519 still contains 2% and 1.8% by weight, respectively, of rice wax, about twice the upper limit recited by claim 1 of the present application. See Examples 1 and 3 of the '519 Patent.

Accordingly, Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn.

Applicants also respectfully request acknowledgement of receipt of the Second Supplemental Information Disclosure Statement filed August 30, 2003. Applicants also respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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